

a releasable fastening means affixed horizontally across either the first or the opposite second side panel at an intermediate location dividing a side panel into an upper section and a lower section; the side panel further being defined by an adjoined upper edge, an adjoined lower edge, a detached side edge and a detached opposite side edge;  
when in the opened position, the upper section being pivoted upward along the upper edge and the lower section being pivoted downward along the lower edge, whereby the covered bag can be inserted into and removed from the cavity of the protective covering.

**REMARKS****112 REJECTIONS**

The examiner rejected claims 8, 9, 16, 20, 21, 24-31 under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter. Applicant amended claims for clarification. Regarding claim 8 and 9, the at least one opening is adapted to accommodate the wheels and the second

opening is adapted to accommodate the stand. Regarding claim 16, applicant amended upper panel to upper section. Regarding claim 20, applicant amended inlet means to housing. Regarding claim 24, upper panel was changed to upper section and bottom panel was changed to lower section. Additionally, bowling was changed to traveling. Claim 18 was renumbered to claim 31. Claim 31 was renumbered to claim 32.

### 103 REJECTIONS

Examiner noted that claims 24-31 were rejected under 35 USC 103 (a) as obvious over Dempsey in view of OH and Battye.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination (See *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990))

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination (See *In re Geiger*, 815 F2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987)).

There must be some reason given the prior art why one of ordinary skill in the art would have been prompted to combine the teachings of the references to arrive at the claimed invention. (See *In re Regel* 188 USPQ).

There is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention....Instead, the relevant inquiry is whether there is a reason,

suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success....Such as a suggestion or motivation may come from the references themselves, from knowledge by those skilled in the art that certain references are of special interest in a field, or even from the nature of the problem to be solved. (See *Smiths Indus. Med. Sys., Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999))

The invention that was made, however, does not make it self obvious; that suggestion or teaching must come from the prior art. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051-52, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (it is insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor); *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (the prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination). (See *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)).

Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of Rouffet's invention to make the combination, this court infers that the examiner selected these references with the assistance of hindsight. This court forbids the use of hindsight in the selection of references that comprise the case of obviousness. (See *In re Gorman*, 933

F.2d 982,986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). Lacking a motivation to combine references, the Board did not show a proper *prima facie* case of obviousness. (See *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed.Cir.1998)).

When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper... Absent such reasons or incentives, the teachings of the references are not combinable. (See *Ex parte Skinner*, 2 U.S.P.Q 2d 1788) Examiner cannot pick and choose among individual parts of assorted prior art references "as a mosaic to recreate a facsimile of the claimed invention.

*Here, Claims 24-31 were added to claim the concept of a traveling bag cover.*

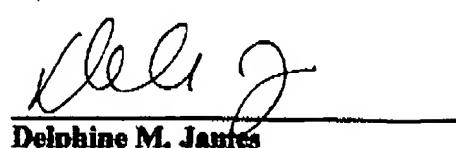
*Dempsey and Battye disclose a covering without openings for a stand or a wheel.*

*There is no attached handle to the covering. Additionally, The inlet means of claims 25-31 are structured differently than Dempsey and Battye.*

*Oh discloses opening in the bottom for wheels but not for a stand. There are not multiple openings in the bottom for a stand and wheel as claimed. Additionally, Oh is an attached cover. Examiner cannot pick and choose teaching to recreate a facsimile of the claimed inventions. There must be something within the art to combine the teachings.*

Applicant respectfully requests that the rejections be withdrawn. Alternately should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he/she is invited to telephone the undersigned.

Respectfully submitted:



Delphine M. James

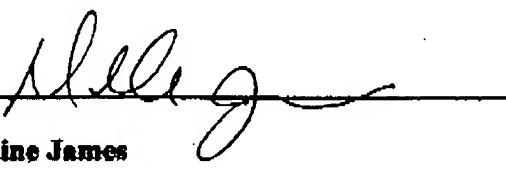
**Registration No. 45,960**  
**Delphine M. James, Attorney At Law**  
**2656 South Loop West Suite 170**  
**Houston, TX 77054**  
**(713)-661-4144**  
**(Fax) 713-661-4145**

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<p>the second upper panel being releasably connected to a side edge of the first upper panel; and</p> <p>at least one opening within the lower panel dimensioned to accommodate the wheels and/or the stand of the covered traveling bag.</p> <p>24. (previously presented): A protective covering for a bowling bag comprising:</p> <p>a housing having substantially an equivalent shape to the bowling bag and a cavity dimensioned to encompass the bowling bag, the housing defined by an upper section, a side panel, an opposite second side panel, a front panel, a back panel and a lower section; a slot within the upper section aligned over the handle of the covered traveling bag, the slot dimensioned to accommodate the handle of the covered bowling bag in a telescoped position therethrough; at least one opening within the lower section dimensioned to accommodate the wheels and/or the stand of the covered traveling bag; and</p> <p>an inlet means providing access for insertion and removal of the traveling bag into the cavity of the housing, the inlet means strategically affixed to exterior surface of a section of the housing.</p> <p>25. (previously presented): The protective covering of claim 24 wherein the inlet means further comprises:</p> <p>a releasable fastening means affixed horizontally across the back panel at an intermediate location dividing the back panel into an upper section and a lower section;</p>